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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Moshe Koppel

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7822

7590

06/14/2006

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EXAMINER

VAUGHN, GREGORY J

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/605,987	<b>Applicant(s)</b> KOPPEL ET AL.	
	<b>Examiner</b> Gregory J. Vaughn	<b>Art Unit</b> 2178	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38, 40-44, 46, 47 and 57-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-38, 40-44, 46, 47, 57 and 58 is/are allowed.
- 6) ☒ Claim(s) 59-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Action Background*

1. This action is responsive to the amendment, filed on 3/27/2006.
2. In the amendment of 3/27/2006, the applicant has amended claims 59-61 and 63-65.
3. Claims 1-38, 40-44, 46, 47 and 57-65 are pending in the case, claims 1, 8, 9, 24, 46, 59, 60 and 61 are independent claims.
4. In the office action dated 12/7/2004, claims 1-38, 40-44, 46, 47, 57 and 58 were allowed. The prosecution of existing claims 59-65 is the subject matter of this office action.
5. Examiner's rejection of claim 60, made under 35 USC 101 in the *Claim Rejections – 35 USC 101* section of the previous office action (dated 12/28/2005) is withdrawn in view of the amended claim and applicant's remarks.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

*"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."*

7. Claims 59, 61-63 and 65 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8. **Regarding claims 59, 61-63 and 65**, the claimed invention fails to produce a useful, concrete or tangible result. The claimed invention as a whole must accomplish a practical application. That is, it must produce a *"useful, concrete and tangible result."* *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. (See MPEP 2106.) Usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also *Schrader*, 22 F.3d at 295, 30 USPQ2d at 1459.

Applicant's invention is directed toward generating search results or documents, from a network, based on a search term or query. Independent claim 59 is directed

toward obtaining an initial set of documents relevant to the search query, assigning relevance scores to the documents, and sorting the documents. Claim 59 describes the steps taken to manipulate (obtaining, assigning and sorting) the non-functional descriptive material (i.e. the set of documents in the system), but fails to describe a tangible result for the set of documents. Independent claim 61 is directed toward providing a search term, generating a limited list of results, generating a limited set of pages, and generating a set of search results. Claim 61 describes the steps taken to manipulate (generate) the non-functional descriptive material (i.e. the list of results, set of pages and set of search results that are stored in the system), but fails to describe a tangible result for the list of results, set of pages and set of search results.

Dependent claims 62, 63 and 65, fail to remedy the deficiencies of independent claims 59 and 61, and are rejected using the same rationale.

Applicant should note that independent claim 60 is statutory, in that the claim incorporates a tangible result, in the positively recites step of *"returning a set of relevant documents to the user"*.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

*"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."*

10. Claims 59-65 remain rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
11. **Regarding claim 59**, the claims recite the following limitations: *"assigning relevance scores to the documents based on cross references between the documents within the initial set"* (second limitation), and *"sorting the documents based on the assigned relevance scores"* (third limitation). The examiner has reviewed the originally filed specification, and has failed to find support for the limitations. Applicant is required to cancel the new matter in response to this office action.
12. **Regarding claim 60**, the claims recite the following limitations: *"generating relevance scores for the documents in the list of relevant documents based on cross references between the documents in the list"* (third limitation) and *"returning a set of relevant documents to the user, the set being sorted based on the relevance scores"*

(fourth limitation). The examiner has reviewed the originally filed specification, and has failed to find support for the limitations. Applicant is required to cancel the new matter in response to this office action.

13. **Regarding claim 61**, the claims recite the following limitations: “*generating a limited list of results indexed to said search term*” (second limitation), “*generating a limited set of pages including links to said limited list and indexed to said search term*” (third limitation) and “*generating a set of search results responsive to the number of links from said limited set to pages in said limited list.*” (fourth limitation).

The examiner has reviewed the originally filed specification, and has failed to find support for the limitations. Applicant is required to cancel the new matter in response to this office action.

14. **Regarding claim 62**, the claims recite the following limitation: “*generating a limited set of pages comprises selecting pages including said search term*”. The examiner has reviewed the originally filed specification, and has failed to find support for the limitations. Applicant is required to cancel the new matter in response to this office action.

15. **Regarding claims 63-65**, the claims fail to remedy the deficiencies of independent claims 59-60, and are rejected using the same rationale.

16. In the response filed 3/27/2006 the applicant has directed the examiner to various portions of the specification in support of the subject matter for claims 59-61. The examiner has reviewed the portions of the specification indicated, and in some

cases found the support to be sufficient, but in other cases not sufficient. A more detailed response is provided in the *Response to Arguments* section of this office action (below).

***Claim Rejections - 35 USC § 102***

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*"A person shall be entitled to a patent unless –*

*(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."*

18. Claims 59-65 remain rejected under 35 U.S.C. 102(e) as being anticipated by Ryan et al., US Patent 6,421,675 (filed 7/15/1998, patented 7/16/2002). "*Ryan et al.*" is hereafter referred to as "*Ryan*".

19. **In regard to independent claim 59**, Ryan discloses generating documents based on a search query. Ryan recites: "*The present invention relates to a method and apparatus that allows for enhanced database searching, and more particularly; for use as an internet search engine*" (column 1, lines 8-10) and "*The results of this*



*search are then displayed to the user, as shown by steps of displaying a created list of web pages"* (column 4, lines 36-38). Ryan discloses obtaining an initial set of documents relevant to the search query. Ryan recites: *"the URL address of the web page or pages that they wish to submit"* (column 5, lines 36-37). Ryan discloses assigning relevance scores to the documents based on the cross references between the documents within the initial set and sorting the documents based on the relevance scores. Ryan recites: *"Hit-list: The list of web-pages URL addresses that is the result of the key-word search. This hit-list ranks the relevance of the web-pages"* (column 6, lines 12-14).

20. **In regard to independent claim 60**, Ryan discloses responding to a search query, obtaining an initial set of documents relevant to the search query and assigning relevance scores to the documents based on the cross references between the documents within the initial set and sorting the documents based on the relevance scores as described in the previous paragraph. Ryan further discloses receiving a search query from a user. Ryan recites: *"The search engine receives the search command, and then using it scans for these key words through a database of web addresses and the text stored on the web sites"* (column 1, lines 25-28).

21. **In regard to independent claim 61**, Ryan discloses providing search results in response to a provided search term, and generating a limited list of results indexed to the search term as described in the previous paragraphs. Ryan discloses generating a limited set of pages including links to the limited list and indexed to the

search term. And generating a set of search results responsive to the number of links from the limited set of pages in the limited list. Ryan recites: "*In an attempt to index the information available on the internet, a number of software search engines have been created via which a user enters a search command*" (column 1, lines 19-22) and "*The search engine receives the search command, and then using it scans for these key words through a database of web addresses and the text stored on the web sites*" (column 1, lines 25-28).

22. **In regard to dependent claim 62**, Ryan discloses selecting pages including the search term. Ryan recites: "*The user typically makes a selection from the list*" (column 1, line 56).

23. **Regarding claims 63-65**, the claims are directed toward a computer-implemented method for the method of claims 59-61, respectively, and are rejected using the same rationale.

#### ***Allowable Subject Matter***

24. Claims 1-38, 40-44, 46, 47, 57 and 58 are allowed, as described in the *Reasons For Allowance* section of the office action dated 12/7/2004.

***Response to Arguments***

25. Applicant's arguments filed 3/27/2006 have been fully considered but they are not persuasive.

***Remarks related to rejections made under 35 USC 101***

26. **Regarding claims 59, 61-63 and 65**, with respect to the rejection made under 35 USC 101, applicant argues that *"In the present claims 59-62, a concrete, tangible and useful result is produced. To wit, relevant search results are presented to a user"* (page 11, third paragraph of the response filed 3/27/2006). Applicant is directed to the rejection, as restated above. Claims 59, 61-63 and 65 fail to produce a tangible result.

***Remarks related to rejections made under 35 USC 112***

27. **Regarding claims 59-62**, with respect to the rejection made under 35 USC 112, applicant has directed the examiner to specific portions of the specification in support of the claims. The examiner has reviewed the portion of the specification indicated. In some cases, support for the claimed subject matter identified by applicant was sufficient, but in other cases the support for the claimed subject matter identified by applicant was insufficient. The following remarks are directed to the identified support that was found to be insufficient.
28. **Regarding claim 59**, the claim recites: *"assigning relevance scores to the documents based on cross references between the documents within the initial set"*

(second limitation). Applicant indicates that page 10, line 6-26 support this limitation. The indicated passage is directed toward ranking of search results and groups of sites. The examiner contends "*document relevance scores*" are not the same as "*search result ranking*" or "*site group ranking*". Applicant suggests that "rank" and "score" are the same thing. "Rank" and "score" are not the same thing. A document with a score of 12 may be ranked 1<sup>st</sup>. A score may be used to determine a rank, however "score" and "rank" are not interchangeable terms.

Applicant points specifically to line 16 of page 10 to support "*cross references between the documents within the initial set*", however, the indicated passage is directed toward "*a plurality of potential hubs are determined in step 128, by searching for sites that include links to any site in one of the groups*". This passage fails to enable one of ordinary skill to make or use the claimed invention.

Claim 59 further recites: "*sorting the documents based on the assigned relevance scores*" (third limitation). Applicant indicates that page 10, line 22 to page 11, line 7 support this limitation. The indicated passage is directed toward "*collating and ranking search results*" and "*filtering sites*". The examiner contends that "*collating and ranking search results*" and "*filtering sites*" are not the same as "*sorting documents*".

29. **Regarding claim 60**, see the previous paragraph for remarks related to lack of support for limitations directed toward "*relevance scores*", "*cross references*" and "*sorting*".

30. **Regarding claim 61**, the claim recites: *"list of results indexed to said search term"* (second limitation). Applicant indicates that page 8, lines 10-15 and page 9, line 31 support this limitation. The page 8 passage is directed toward *"search engine 106 utilizes a database 108 that contains indexes and other information relating to WWW pages"*. The page 9 passage is directed toward *"locating a plurality of sites", "the listing of links", "providing link lists", "optional filtering steps" and "other possible filtering rules"*. The examiner contends that *"database index"* is not the same as *"results indexed to said search terms"*; and that *"locating sites, a list of links" and "filtering"* are not the same as *"results indexed to said search term"*. The balance of claim 61 limitations are similarly not supported by the specified passages.

***Conclusion***

31. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

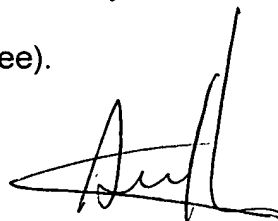
32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Art Unit: 2178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn  
June 8, 2006

A handwritten signature in black ink, appearing to read 'S. Hong', with a long horizontal stroke extending to the right.

**STEPHEN HONG**  
**SUPERVISORY PATENT EXAMINER**